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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,370	01/02/2001	Stanley E. Woodard	LAR 15959-1	1665
7590 04/01/2005				
Mr. Stanley E. Woodard P. O. Box 7976 Hampton, VA 23666			EXAMINER LEE, BENJAMIN C	
			ART UNIT 2632	PAPER NUMBER
DATE MAILED: 04/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,370

Applicant(s)

WOODARD ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 19-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Appendix for Pro Se Applicant.

DETAILED ACTION

Election/Restrictions

1. Original-filed claims 1-72 were subjected to election/restriction requirements set forth in the previous Office action. Pro Se Applicant has responded by electing the claims of choice by submitting rewritten current **claims 1-21 without traverse** (by virtue of lack of “with traverse” indication from Applicant) from Group II: original Claims 31-49 and subspecies. However, current claims 1-21 do not all correspond to original claims 1-21, and there are no mark-up indications of alterations/modifications in the claims from the original claims 1-21 text. As such, Applicant is hereby notified that proper claim/amendment format requires proper claim identifiers, and listing of all claim numbers including those that are amended, new, cancelled and withdrawn, and showing amendment changes by brackets and underlines, and addition of new claims using a claim number consecutively beginning with the number next following the highest numbered claim previously presented (see Appendix guidelines for detail). It appears that Applicant intended to respond to the restriction requirement by cancellation of original claims 1-72 and submitting new claims 73-93 (that are currently numbered claims 1-21) as per Examiner’s phone conversation with Applicant on 3/25/05. If that is the case, Applicant is hereby advised to indicate such cancellation and addition using the provided Appendix guidelines. Distinction between claims that are to be “withdrawn” and those that are to be “cancelled” should be recognized.

2. Furthermore, current claims 19-21 correspond to non-elected original claim 50 of Group III in the Election/Restriction requirement of the previous Office action; therefore, **claims 19-21 are withdrawn from consideration as being non-elected claims.**

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3. **Current claims 1-18 are being considered** in the following Office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-12 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 9, lines 1-2, the claim should have depended on claim 4 in order to provide antecedent basis for “wherein at least one acoustic member comprises...”

2) Claims 10-11 are similarly rejected by virtue of their dependency on claim 9 and thereby incorporating the same deficiencies.

3) Claims 12 and 14 lack essential elements, such as the acoustic member structure of claim 11, to produce the claimed results of “audible sound over substantially the entire audible frequency range”.

4) In claim 15, lines 1-2, the claim should have depended on claim 4 in order to provide antecedent basis for “wherein the point of attachment of at least one acoustic member...”

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-8, 13 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Saarmaa et al. (US pat. #6,198,206).

1) Regarding claim 1, Saarmaa et al. discloses the claimed:

Claim 1: A multi-functional device (Abstract) for producing mechanical vibrations in response to an electrical signal, comprising a piezoelectric component (10b of Fig. 1; Fig. 4) having two opposing surfaces, said piezoelectric component further having at least two points where polarity is recognized (positive-and-negative electrodes connections shown in Figs. 1; 13 in Fig. 2; col. 5, lines 19 & 33-35; col. 10, line 17).

Claim 2: The device according to claim 1, wherein the piezoelectric component comprises a unimorph piezoelectric structure having piezoelectric material bonded between two metallic support layers (10a-10c in the embodiment of Fig. 1 and col. 4, lines 13-27; col. 5, line 18; col. 10, lines 4 and 45).

Claim 3: The device according to claim 1, wherein the piezoelectric component comprises a bimorph piezoelectric bimorph having piezoelectric material bonded to two different surfaces of a metallic support layer (col. 4, lines 28-48; col. 5, lines 22 and 64 and col. 10, lines 4 and 45).

Claim 4: The device according to claim 1 wherein at least one acoustic member is attached to one of the surfaces of the piezoelectric component (3 of Fig. 3C, for example, whereby mass/weight 3 constitutes an inertial member that influences the vibrational/acoustic characteristics of the device according to col. 6, lines 5-12.)

Claim 5: The device according to claim 1 wherein the piezoelectric component has a T-shaped platform that comprises a neck region extending from one side of the piezoelectric component (Fig. 4, whereby when the neck portion is inserted into a socket a neck region remains according the insertion configuration shown at left end of Fig. 3A.)

Claim 6: The device according to claim 5 further comprising a clamp, connected at the neck region of the piezoelectric component, for coupling the piezoelectric component to a base in a cantilever fashion (piezoelectric component configurations of Fig. 4, when inserted into respective socket clamps as shown in Fig. 1.)

Claim 7: The device according to claim 1 further comprising a clamp, connected at one end of the piezoelectric component for coupling the piezoelectric component to a base (met by consideration of claim 6 above.)

Claim 8: The device according to claim 1 further comprising means, positioned at one end of the piezoelectric component, for adjustably connecting the piezoelectric component to a base surface (320 in Fig. 3A and col. 10, lines 41-54 whereby bolt holes attachment constitutes the claimed adjustable connection.)

Claim 13: The device according to claim 1 wherein the mechanical vibrations are of sufficient force as to be readily felt by a holder of the device (Abstract).

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Claim 16: The device according to claim 1, wherein a dampening material of low elastic modulus substantially covers at least one surface of the piezoelectric component (10a or 10c of Fig. 1, whereby since the claimed "low elastic modulus" is not specific as to "how low" or relative to what, 10a or 10b meets such claimed limitation.

Claim 17: "A device for producing mechanical vibrations in response to an electrical signal, comprising a piezoelectric component having two opposing surfaces, said piezoelectric component further having at least two points where polarity is recognized; and wherein the piezoelectric component has a T-shaped platform that comprises a neck region extending from one side of the piezoelectric component" is met as in the consideration of claim 5 above.

Claim 18: "A device for producing mechanical vibrations in response to an electrical signal, comprising a piezoelectric component having two opposing surfaces, said piezoelectric component further having at least two points where polarity is recognized; and wherein a dampening material of low elastic modulus substantially covers at least one surface of the piezoelectric component" is met as in the consideration of claim 16 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9-10, 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saarmaa et al.

1) Regarding claims 9-10, Saarmaa et al. met all of the claimed subject matter as in claim 1, except: specifying the claimed wherein at least one acoustic member comprises a surrounding wall portion having a bottom surface and a top surface, the surrounding wall portion extending along a direction substantially perpendicular from the bottom surface to the top surface, the bottom surface being operatively connected to the piezoelectric component, and further comprises an end portion, operatively connected to the top surface of the surrounding wall portion, to form an enclosed chamber within the acoustic member when the bottom surface of the acoustic member is connected to the piezoelectric component.

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that the acoustic member that is constituted by the weight/mass (3 of Fig. 3C, col. 6, lines 8-12, which could be combined with the piezoelectric component of Fig. 4) in Saarmaa et al. can be implemented in various ways, including one constructed using a surrounding wall portion having a bottom surface and a top surface, the surrounding wall portion extending along a direction substantially perpendicular from the bottom surface to the top surface, the bottom surface being operatively connected to the piezoelectric component, and further comprises an end portion, operatively connected to the top surface of the surrounding wall portion, to form an enclosed chamber within the acoustic member when the bottom surface of the acoustic member is connected to the piezoelectric component.

2) Regarding claim 12, Saarmaa et al. met all of the claimed subject matter as in claim 1, except: specifying the claimed wherein the mechanical vibrations are of sufficient force to produce audible sound over substantially the entire audible frequency range.

However, since device of Saarmaa et al. is able produce mechanical vibrations of sufficient force to produce a wide range of sensory signals including audible sounds (Abstract), and since the claimed invention does not include any structure or means different from the Saarmaa et al. device, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that the Saarmaa et al. is able to produce mechanical vibrations just as well as the claimed invention.

3) Regarding claim 14, Saarmaa et al. met all of the claimed subject matter as in claim 1, plus the obvious consideration of claim 12 regarding the claimed wherein the mechanical vibrations are of sufficient force as to produce audible sound over substantially the entire audible frequency range, and the claimed production of audible alerting signal and a tactile alerting signal is met by the Abstract.

4) Regarding claim 15, Saarmaa et al. met all of the claimed subject matter as in claim 1, except: specifying the claimed wherein the point of attachment of at least one acoustic member is approximately at an anti-node of the piezoelectric component.

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that the placement of the acoustic member of Saarmaa et al. having the form of the mass/weight at the free end of the cantilevered-mounted piezoelectric component to oscillate, as shown in Fig.3C, for example, produces inertial oscillations where the point of attachment approximately coincides with an anti-node of the piezoelectric component.

Allowable Subject Matter

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10. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:
The claimed multi-functional device for producing mechanical vibrations in response to an electrical signal, comprising a piezoelectric component for receiving opposite polarity electrical signals, and at least one acoustic member attached to one of the 2 opposing surfaces of the piezoelectric component and wherein the acoustic member forms an enclosed chamber with an orifice and is of a specific construction in the claimed manner that essentially forms a whistle mounted on the mechanically vibrating piezoelectric component and thereby moves with it to create additional sounds, is not taught or suggested in the prior art.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Rollins et al., US pat. #6,078,126

--Illustration of the anti-node point at the free end of a cantilever (Figs. 4 and 7).

2) Perkins et al., US pat. #6,359,371

--Another similar inertial/audio device.

3) Stephens, US pat. #4,122,365

--A similar piezoelectric buzzer.

4) Lee et al., US pat. #6,211,755

--A similar vibration and audible device.

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5) Saiki et al., US pat. #6,208,237

--A similar electromechanical and acoustic transducer.

6) Johnson, US pat. #4,809,552

--A T-shaped multidirectional transducer.

7) Nakamura, US pat. #4,593,160

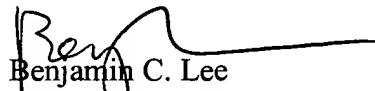
--A similar piezoelectric speaker.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
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B.L.

Appendix

1. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form may be required. While an application can be amended to make it clearly understandable, no subject matter (new matter) can be added that was not disclosed in the application as originally filed.

2. Following are the copies of § 37 CFR 1.111 (Reply by applicant or patent owner to a non-final Office action), § 37 CFR 1.112 (Reconsideration before final action), § 37 CFR 1.113 (Final rejection or action), § 1.121 (Manner of making amendments in application), and § 37 CFR 1.126 (Numbering of Claims) are provided below regarding the proper format and contents of an application and its amendments:

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Director. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

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- (ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.
- (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the Examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.
- (c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.
- [46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are

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made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing

prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this

section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

§ 1.121 Manner of making amendments in application.

(a) Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) Specification. Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) Amendment to delete, replace, or add a paragraph. Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and;

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) Amendment by replacement section. If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

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(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification . The specification, other than the claims, may also be amended by submitting::

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section . A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document . Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the

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status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) Drawings. One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the header, labeled “Replacement Sheet.” Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. All changes to the drawing(s) shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Marked-up Drawings” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) Disclosure consistency. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) No new matter. No amendment may introduce new matter into the disclosure of an application.

(g) Exception for examiner’s amendments. Changes to the specification, including the claims, of an application made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

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- (h) Amendment sections. Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.
- (i) Amendments in reissue applications. Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.
- (j) Amendments in reexamination proceedings. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.
- (k) Amendments in provisional applications. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

3. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

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1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

4. It has called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows.

AI hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 2023 1, on..."

Name of applicant, assignee, or Registered Representative

Signature _____

Date _____